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| 10/523,866 | 09/15/2005 | Anahit Tataryan | 3361-US-1 | 1881 |
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| EXAMINER CHANG, VICTOR S | | | | |
| ART UNIT 1794 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/523,866

Applicant(s)

TATARYAN ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-52, 63 and 64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-52, 63 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 11/4/2009 have been entered. Claims 32, 34, 41, 47 and 49 have been amended. New claims 63 and 64 have been added. Claims 32-52, 63 and 64 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response, the grounds of rejections have been updated as set forth below. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 103

4. Claims 32-33, 35-52, 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stipek [US 3914483], and evidenced by Aoyagi [US 4032679].

Stipek's invention relates to a multiple part label. Figs. 1 and 2 illustrate a roll of labels 13 comprising in order an indicia carrying sheet 17 (facestock), a pressure sensitive adhesive layer 19 (second means), and a backing sheet 15 coated with release agent (release liner, or third means). The backing sheet is cut along a closed line 21 which is located inwardly of the periphery 23 of the label. The closed cut line 21 defines a backing portion 25 located entirely within the boundaries of the label 13. The indicia carrying sheet 17 is cut completely through along one closed line 31 thereby forming an inner removable label 33. The inner removable label 33 may have imprinted indicia 41. The indicia may be the name of the manufacturer,

distributor, packer, etc., or other information for identifying a container or package [col. 1, ll. 45 through col. 2, ll. 29; col. 3, ll. 14-16]. Figs. 5 and 6 illustrate the relative die cut positions in the label carrying sheet 17 and the backing sheet 15 [col. 1, ll. 39-42].

For claims 32-33, 35-46 and 48-52, in Stipek's Fig. 6, die cuts 51 and 53 read on the second and first the weakened lines, respectively. Stipek teaches all the features of the labels of the claimed invention. Regarding the term "first means" of "a print-receptive coating", since Stipek teaches that information for identifying indicia is imprinted on the label carrying sheet 17, the outer surface of the label carrying sheet reads on the "first means". Regarding the use languages throughout the claims, i.e., printing the indicia as "send-reply mailing address", the steps of using the label for mailing, newly added limitation "adapted for selective application to a mailing article and receptive to marking with mailing address indicia" in claims 32 and 49, and the newly amended limitation in claim 41 "the release liner has a weakened line therein underlying the send-reply mailing address label but not the reply mailing address label to form a release liner member", since statements of intended use do not serve to distinguish structure over the prior art, they have not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Alternatively, even if the use languages are considered, the Official notice "using a label with preprinted address for mailing is common and well known" has been reconsidered and maintained, as evidenced by Aoyagi's teaching of sticker. Specifically, Aoyagi teaches that sub-label is imprinted with information, including mailing information. It would have been an obvious to one of ordinary skill in the art of label to modify Stipek's label with an indicia of preprinted address for mailing. Finally, regarding the use steps during mailing, since the process limitations have not been shown on the record to

produce a patentably distinct article, the formed articles are rendered *prima facie* obvious, and this limitation at the present time has not been given patentable weight.

For claims 47, 63 and 64, Stipek illustrates in Fig. 2 that plurality of labels 33 can be formed by multiple weakened lines 31, the term “fourth weakened line” is read upon by the plurality of the weakened lines 31. More particularly, while the cross-section view in Fig. 6 illustrates a single label 33 formed by second weakened line 53 at a cross-section, which is within the first weakened line 51, additional weakened lines 53 at a different cross-section for a second label of the plurality of labels 33 taught by Stipek read on the “fourth weakened line”.

5. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stipek [US 3914483], evidenced by Aoyagi [US 4032679], and in view of admitted prior art [APA].

The teachings of prior art are again relied upon as set forth above.

For claim 34, Stipek is silent about newly added limitation “said facestock layer being coated with said print receptive coating”. However, APA admitted that such a coating is known in the art [spec., pp. 13, ll. 31 through pp. 14, ll. 1]. It would have been an obvious modification to apply a print receptive coating to Stipek’s facestock, motivated by the desire to improve the reception of printing or indicia.

Response to Arguments

6. Applicants argue at Remarks page 8:

“the indicia 41, 43 and 45 on the label portions 33 are not mailing address indicia. Rather, this indicia is expressly identified in Stipek as a “coupon” or “decorative” designs, e.g., such as identification or pricing.”

However, Stipek teaches various uses of the labels, including uses such as the name of the manufacturer, distributor, packer, etc., or other information for identifying a container or package. Clearly, Stipek does not exclude the use of label for providing common mailing information, as evidenced by Aoyagi's teaching set forth above. Applicants are reminded that in the BPAI decision dated 9/18/2006 has affirmed the examiner's finding that Aoyagi discloses a removable sub-label "having mailing information printed thereon. See page 11, paragraph 3.

Applicants argue at page 8:

"nowhere does Stipek teach mailing address indicia being imprinted on the inner removable label 33. On the contrary, Stipek only teaches that the inner removable label 33 contains coupon and decorative design indicia."

However, Stipek teaches various uses of the labels, including uses such as the name of the manufacturer, distributor, packer, etc., or other information for identifying a container or package. It would have been obvious to use Stipek's label for providing common mailing information identifying a container or package for a distributor or packer.

Applicants argue at page 9:

"even if it were appropriate to take Official notice, preprinted mailing labels do not read on the current claims."

However, applicants are reminded that in the BPAI decision dated 9/18/2006 has affirmed the examiner's finding that Aoyagi discloses a removable sub-label "having mailing information printed thereon. If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007).

Finally, in view of the updated grounds of rejections, the remaining arguments related to amended limitations are moot.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794